

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLN. NO. 09/759,219
ATTORNEY DOCKET NO Q62673

REMARKS

Applicant thanks the Examiner for acknowledging Applicant's claim to foreign priority, and for indicating that the certified copy of the priority document, Japanese Patent Application No. 2000-007641 dated January 17, 2000, has been made of record in the file.

Claims 1-5 have been examined on their merits.

Applicant thanks the Patent Office for indicating that claims 4 and 5 are allowed.

The Examiner objects to claims 2 and 3 as being dependent upon a rejected base claim. Applicant thanks the Examiner for indicating that claims 2 and 3 would be allowed if rewritten in independent form. However, instead of rewriting claims 2 and 3 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Claims 1-5 are all the claims presently pending in this application.

The Patent Office objects to claims 2 and 3 as being dependent upon a rejected base claim. Applicant thanks the Patent Office for indicating that claims 2 and 3 would be allowed if rewritten in independent form. However, instead of rewriting claims 2 and 3 in independent form, Applicant respectfully traverses the prior art rejections for the reasons set forth below.

Applicant herein amends claim 1 to recite changing a DC-offset follow-up speed based on both a frame continuation detection signal and a received frame signal. Applicant submits that the amendment to claim 1 places the application in condition for allowance, since claim 1 now recites elements that the Patent Office has indicated as allowable. Entry and consideration of the amendment to claim 1 is respectfully requested.

Claims 1-5 are all the claims presently pending in the application.

1. Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Applicant's Admitted Prior Art ("AAPA") in view of Ziporovich (U.S. Patent No. 5,886,842). Applicant traverses the rejection of claim 1 for at least the reasons discussed below.

The Patent Office acknowledges that AAPA fails to disclose that the DC offset follow up speed is calculated when a preamble portion is being received. The Patent Office alleges that Ziporovich provides the necessary disclosure to overcome the acknowledged deficiencies of AAPA.

The combination of AAPA and Ziporovich fails to teach or suggest at least changing a DC-offset follow-up speed based on both a frame continuation detection signal and a received frame signal, as recited in claim 1. As noted by the Patent Office, Ziporovich discloses, *inter alia*, learning an appropriate DC offset correction value when a disk drive head is reading a known data preamble pattern during acquisition mode. *See* col. 6, lines 13-16 of Ziporovich. There is no disclosure that during acquisition mode that the known data preamble reduces a DC offset follow up speed, or that the known data preamble even initiates such a reduction. Ziporovich uses the preamble to adjust the DC offset in a control loop that includes shift registers that add preamble samples together to obtain a DC offset, which is contrary to the invention recited in claim 1. *See, e.g.*, col. 9, line 14 to col. 10, line 8 of Ziporovich. Furthermore, there is no teaching or suggestion in Ziporovich of changing a DC-offset follow-up speed based either a frame continuation detection signal and/or a received frame signal. Furthermore, Applicant submits that even if one were to combine AAPA and Ziporovich, the resulting combination

would not arrive at the present invention, since there is no disclosure, in either AAPA or Ziporovich, which teaches or suggests that a DC offset follow up speed is controlled based on frame continuation detection signal and a received frame signal. Thus, Applicant submits that the Patent Office cannot fulfill the “all limitations” prong of a *prima facie* case of obviousness, as required by *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991).

Applicant submits that one of skill in the art would not be motivated to combine the two references. *In re Dembiczak* and *In re Zurko* require the Patent Office to provide particularized facts on the record as to why one of skill would be motivated to combine the references.

Without a motivation to combine, a rejection based on a *prima facie* case of obviousness is improper. *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998)). Although the Patent Office provides a motivation analysis with respect to finding a “learning curve” by using a preamble, both the AAPA and Ziporovich lack any teaching or suggestion about the desirability of controlling a DC offset follow up speed is controlled based on frame continuation detection signal and a received frame signal reduction. Thus, Applicant submits that the Patent Office cannot fulfill the motivation prong of a *prima facie* case of obviousness, as required by *In re Dembiczak* and *In re Zurko*.


Based on the foregoing reasons, Applicant submits that the combination of AAPA and Ziporovich fails to teach or suggest all of the claimed elements as arranged in claim 1. Thus, Applicant submits that claim 1 is allowable, and respectfully requests that the Patent Office withdraw the § 103(a) rejection of claim 1.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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